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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,035

09/15/2006

Ichiro Kakihara

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

11/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,035	<b>Applicant(s)</b> KAKIHARA ET AL.	
	<b>Examiner</b> Terressa M. Boykin	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**Response to Arguments**

Applicant's arguments filed 11-13-08 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., used filters, clogged with foreign matter). Note that applicants statement that

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On the other hand, the present invention relates to a method in which the used filter(s) (clogged with foreign matters) is taken out from the production system and washed using specific washing agents in a specific manner (i.e., features (ii) to (viii) mentioned above), thereby achieving excellent effects (i.e., efficient cleaning of the filter while suppressing the variation of the terminal hydroxyl group ratio of the aromatic polycarbonate produced, thereby enabling stable production of a high quality aromatic polycarbonate).

”

are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is also noted that applicants claim are not directed to the crux of the specification wherein there is a:

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cleaning of the filter while suppressing the variation of the terminal hydroxyl group ratio of the aromatic polycarbonate produced, thereby enabling stable production of a high quality aromatic polycarbonate. Such effects of the method of the present invention are quite unexpected from the prior art.

Thus, although the prior art of record does not specifically state or is directed to the cleaning of the filter for a specific purpose, such purpose appears to be not necessary in view of the present claims since the resulting polycarbonate and characteristics thereof have not been stated.

#### **Claim Rejections - 35 USC § 112**

**Claims 1- 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Although the applicants amendments and arguments are fully appreciated, applicants preamble continue to lend itself to the confusion as stated previously.

As, if the crux of the invention is directed to the mechanical washing and movement of the filter and not the process of making a polycarbonate, such may be better expressed as an apparatus claim. However, if applicants' intention is to produce a novel or unobvious method for producing a polycarbonate, note that the process should recite the steps that lead to the production of the polycarbonate. Those positive, active steps and any *process parameters* necessitated by the specification that *lead to the*

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*production of the polycarbonate* should "clearly set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Moore, 169 USPQ 236, and make it clear what subject matter the claim encompasses, as well as make clear the subject matter from others would be precluded. In re Hammack 166 USPQ 204.

Applicants' claims as now written do not address the issue above with respect to claim 2. As was noted, the pH as claimed in claim 2 and set forth in applicants specification on page 9 lines 1-10 since the terminal hydroxyl group ratio may vary greatly and thus cause "instability", *the pH appears to be essential to the process conditions*. For example, applicants state in claim 2 that pH of 7.5-10 is used. However, is the method inoperable at a pH of 7.1 which would still be basic but not within the range as set forth either in the specification or the claims. Clarification and correction required.

Again, on page 7 and with respect to claim 1 line 9, in light of the preamble, there remains confusion with respect to mechanical movement of the filter and where the location of the moieties are at that time, i.e. reactants, washing agents etc. Note as that it is not clear where the method of washing is directed to the filter or to the reactants etc. The question fairly arises in light of lines 12-16 of applicants' claim 1 and in view of the specification on page 7 line 24 through 4.

Although applicants' arguments with respect to the prior art is understood, since the above lack of clarity with regard the process remains, the previous rejection over the prior art will remain until further clarification has been made.

**Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terressa M. Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday-Thursday 10-5:30 Friday (work at home).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Terressa M. Boykin/

Primary Examiner, Art Unit 1796

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